

Atty's 21543

Pat. App. 09/603,528

**REMARKS:**

The present amendment is submitted in an earnest effort to advance this case to issue without delay.

1. Claim 1 has been amended to remove the functional statement with respect to the biological sample from the preamble and to insert it into the body of the claim as part of a structural limitation to ensure that it has due patentable weight. This is intended to assist in distinguishing the claimed sampling tube and method of making it from a tampon inserter.

In addition, claim 1 has been amended to specifically recite the step of forming the intermediate bottom (5) so that it is integral with the wall (2) and of conical shape with its apex pointed in the direction of the end of the tube to be formed with a rounded bottom.

In addition, claim 1 has been amended to expressly state that the rounding of the bottom which takes place externally of the mold in which the tube is formed, only partly closes the bottom and provides a bottom which renders the tube self-orienting to facilitate removal of a sample by a pipette (page 10, lines 16-19).

Claims 2 and 4 have been canceled along with claims 6-9 which have been withdrawn from consideration as directed to a nonelected invention and for which a divisional application may be filed. Claim 5 has been amended to be directly dependent from claim 1.

Claims 1 and 5 are in the case.

Atty's 21543

Pat. App. 09/603,528

2. Applicant appreciates the fact that the rejection of claim 1 as anticipated by GUEST (A) and as obvious from KLIMASZEWSKI, JR. (B) have been withdrawn and that there is no longer any rejection of GUEST in view of HUANG (C).

3. As noted, applicant reserves the right to divide for claims 6-9.

4. The rejection of claims on BERGER et al (A) under 35 USC 102(b) is respectfully traversed even without the present amendments to claim 1. Applicant does not agree that the recitation in a preamble *ipso facto* precludes reliance upon a limitation so recited. The Examiner has cited, for example, *In re Hirao*, 190 USPQ 15, for its proposition and applicant cannot see that case as standing for that which the Examiner has stated. In the HIRAO case, the issue was a product by process and the question as to the preamble was whether the preamble contributes. There the preamble merely recited the purpose of the process which did not depend upon the preamble for completeness. In fact the issue was could the process steps stand alone, and they did. The issue of whether the preamble could contribute to distinguishing over the art was not the issue in that case.

In the KLIMASZEWSKI, Jr. case cited by the Examiner, the question was whether the preamble could be a limitation where the portion of the claim was a self-contained description. In that case the court expressly noted that there are situations where the

Atty's 21543

Pat. App. 09/603,528

preamble gave life, meaning and vitality to a claim. Where is that more important than in a case like the present where it gives life and meaning to the making of a sample tube to underscore its distinction from a tampon inserter.

Furthermore applicant cannot find in BERGER et al any teaching of the molding of an intermediate bottom spaced between ends of the tube, and that alone would remove claim 1 from anticipation by BERGER et al. (Note that an intermediate bottom would likely prevent the tube from being used as a tampon inserter at all). The original rejection of claims as anticipated by BERGER et al cannot stand

5. To avoid any suggestion that claims 1 and 5 might be obvious from BERGER et al, claim 1 has been amended to require the tube to have a well which can receive a biological sample, and the bottom to be only partially closed and self-orienting to allow pipetting of the sample from the well. None of that is in any way suggested by BERGER et al.

Claims 1 and 5 are thus deemed to be allowable.

6. A petition for an automatic three month extension of the term for reply is enclosed. A charge form for the extension fee is also enclosed.

7. Since the Office Action has been made Final here, this application is also accompanied by a formal request for

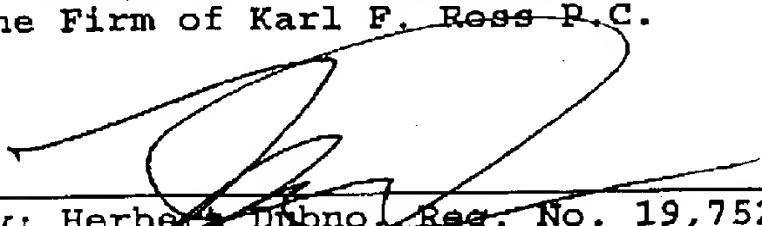
Atty's 21543

Pat. App. 09/603,528

continued examination together with a charge form covering the fee..

Further and favorable action is urged.

Respectfully submitted,  
The Firm of Karl F. Ross P.C.



By: Herbert Dubno, Reg. No. 19,752  
Attorney for Applicant

ef-

8 July 2004

5676 Riverdale Avenue Box 900

Bronx, NY 10471-0900

Cust. No.: 535

Tel: (718) 884-6600

Fax: (718) 601-1099

Enclosures: Petition for 3 mo. ext.

Chg fm for \$950.

Request for cont'd exam.

Chg fm for \$770.